REMARKS

Claim 31 of the present application is not, as asserted, a combination of claims 20 and 28 of the '443. Hopefully, the Examiner has the right sets of claims. There was a reply filed in the '443 application on March 3, 2008 and a second supplemental amendment filed in this case on August 23, 2005.

Claim 31 differs from claim 20 in that it includes, in the first clause, the language "including an interruptible content portion" and, in the third paragraph, "said portion while said portion is still stored in said cache, insert said advertisement in said portion and output for display, said portion with an inserted advertisement." The reason why claim 28 is believed to be relevant is not understood since it calls for parsing from the content in the advertisement instructions for determining when said content might be interrupted. In view of the difference between the independent claims, the dependent claims must, likewise, be distinguishable. Clearly, reconsideration of the rejection would be appropriate.

As pointed out in M.P.E.P. § 804 at page 800-19, a double patenting rejection exists when the same invention is being claimed twice: "same invention, means identical subject matter." A reliable test for double patenting is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. Clearly, the claims are substantively different.

Claim 31 requires that the advertisement be inserted in the interruptible content portion which is not even set forth in the allegedly corresponding claim and requires that it be done so "while said portion is still stored in said cache." Further, it requires that the advertisement be inserted in said portion of the output for display and said portion with the inserted advertisement. Clearly, this is not the same invention. Different elements are implicated and a different sequence of operation is described.

The argument that claims 44-47 can be "derived" from the '443 application, claims 33-35 since the user can access and control the display and content in a similar manner as described therein certainly corresponds to no known case law with respect to double patenting. It is respectfully submitted that it fails to provide the required double patenting analysis and is insufficient as a matter of law.

Similarly, that the arguments that claims 1-4, 6-10, and 11-19 "for a corresponding method a medium for storing instructions, if executed, enable a processor-based system to perform steps as in claims 31-47," is noted and this difference between method and software, in and of itself, establishes that a Section 101 double patenting rejection could not possibly apply. Again, there is lack of identity of claimed subject matter.

Further, with respect to claim 1 of this application versus claim 20 of the cited application, there appears to be no reasonable correlation between the claim elements. For example, there is no corresponding element to any of the method steps, most particularly, inserting said advertisement in said portion and outputting for display said portion with said inserted advertisement. Moreover, the language of the first three claims is materially different.

There is simply no way to say that identical subject matter is claimed.

With respect to differences between claims that also differ based on method versus medium for storing instructions, it is clear that the medium does not have the same scope as the method since the medium can only be infringed when instructions are used to implement the steps, whereas a method could be infringed by hardware or other techniques.

In short, there is no basis to assert that the claimed subject matter is identical. Arguments that claims can be "derived" or claims that a processor system could perform steps as set forth in other claims, are insufficient to meet the requirement of identity of invention. Reconsideration is appropriate.

Respectfully submitted,

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